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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/518,323

10/04/2005

Hamm-Chan Kang

7332P001

6739

8791

7590

06/23/2010

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EXAMINER

PRANGE, SHARON M

ART UNIT

PAPER NUMBER

3728

MAIL DATE

DELIVERY MODE

06/23/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/518,323	<b>Applicant(s)</b> KANG, HAMM-CHAN	
	<b>Examiner</b> SHARON M. PRANGE	<b>Art Unit</b> 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/24/10 has been entered.

Claims 1 and 5 remain pending in the application.

### ***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu (Japanese Patent Application No. 10165203) in view of Miyata (US Patent No. 5,758,435), Hines (US Patent No. 6,502,331), and Harmon-Weiss et al. (US 6,253,466), herein Harmon-Weiss.

Shimizu discloses a plurality of seat holes (3) formed in a bottom sole (1) with metal bodies (weight bodies 4) fixed in the seat holes. As shown in Fig. 1, the size of the seat holes decreases from the heel part of the sole to the front part. Fig. 4 shows that the weight bodies are made to fit closely within the bounds of the seat holes.

Shimizu discloses that the seat holes and weights may be in different shapes and arrangements (Fig. 1, 7), for example strips or small rectangles, but does not disclose round seat holes or weights in the form of balls.

Hines teaches that it is well known to provide weights in shoes in different shapes, including balls (spheres). Providing smaller pieces provides easy shaping of the sole to the foot in the transverse direction (column 3, lines 3-20). It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the weights in the sole of Shimizu in the shape of a ball, as this would be a simple substitution of one shape for another, with the predictable result of providing greater flexibility in the transverse direction. It further would have been obvious to provide seat holes in a round shape to closely fit the shape of the weight bodies.

Shimizu further does not disclose a layer of insole, middle sole, and cushion layers. Miyata teaches providing an insole layer (11), middle sole layer (10), sponge layer (14a), and cushion layer (14b) above a sole in a shoe for comfort and shock absorption. It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided insole, middle sole, and cushion layers, as taught by Miyata, to the sole of the combination of Shimizu and Hines in order to provide added comfort and shock absorption to the wearer.

The combination of Shimizu, Miyata, and Hines does not disclose refraction lines formed at the front of the sole. Harmon-Weiss teaches the inclusion of transverse grooves (118) formed in the width direction at the front of the sole of a shoe in order to increase flexibility at this portion of the sole (column 9, lines 25-33; Fig. 9). It would have

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been obvious to one of ordinary skill in the art at the time of the invention to have provided grooves, as taught by Harmon-Weiss, at the front end of the sole of the combination of Shimizu, Hines, and Miyata in order to increase flexibility at the front portion of the sole.

### ***Response to Arguments***

4. Applicant's arguments filed 2/24/10 have been fully considered but they are not persuasive.

Applicant argues that the in the combination of Shimizu and Hines, the sphere shaped weights of Hines would not fit in the rectangular seat holes of Shimizu, and it would require a substantial redesign to accommodate the sphere shaped weights. However, Shimizu clearly teaches that the seat holes are shaped to closely fit the shape of the weights. Therefore it would have been obvious to provide round seat holes for the sphere shaped weights. Changing the shape of the seat holes is not a substantial redesign, but is also a simple substitution of one shape for another. Applicant further argues that seat holes of Fig. 7 of Shimizu are of a uniform size, and therefore a combination of Shimizu and Hines would result in an even distribution of weight. However, Fig. 1 clearly shows a weight distribution where the weight is reduced from the heel to the front part of the sole. Applicant argues that the weights of Hines are molded into an insole, and therefore Hines does not suggest the size and placement of the weights. However, Hines teaches weights which may be placed into pockets (16) provided in an insert (column 3, lines 28-38).

Applicant argues that one would not be motivated to combine Shimizu and Hines with Miyata because Miyata teaches a uniform distribution of weight, therefore teaching away from the combination of Shimizu with Miyata. Although Miyata does teach an even distribution of weight within the sole of the shoe, the distribution of weight in the sole of Miyata is irrelevant to the combination of the two references. The Miyata reference is used as a teaching for providing cushion layers above the sole of a shoe. The distribution of weight within the sole of the shoe of Miyata has no bearing on the combination of the two references, because it has no bearing on the cushioning layers of the shoe.

Applicant argues that the partition 5 of Shimizu is narrow, and so would not allow the formation of a refraction line. However, there are no actual dimensions associated with the partitions of Shimizu. Depending on the width of the both the partitions and the refraction lines, it would be possible to provide refraction lines to the sole of Shimizu, therefore providing increased flexibility to the sole.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHARON M. PRANGE whose telephone number is (571)270-5280. The examiner can normally be reached on M-F 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. M. P./                      6/18/10  
Examiner, Art Unit 3728

/Mickey Yu/  
Supervisory Patent Examiner, Art  
Unit 3728